

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. FRENCH
AND LORIN E. ULLMANN

Appeal 2007-1425
Application 09/731,631
Technology Center 2100

Decided: October 17, 2007

Before KENNETH W. HAIRSTON, JAY P. LUCAS, and SCOTT R. BOALICK,
Administrative Patent Judges.

BOALICK, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-23, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

Independent claims 11 and 18, and dependent claims 12-17 and 19-23, each recite means-plus-function limitations.¹ Independent claims 11 and 18 are reproduced below:

11. Computer program product in a computer usable medium for selecting an operating system at a target device, comprising:

means for initiating network bootstrap program code at the target device;

means for receiving a command requesting an operating systems list of at least one operating system;

means for sending the operating systems list to the target device before an operating system is executed at the target device; and

means for receiving a selection of a target operating system from the operating systems list, wherein the target device is to be remotely booted by the server.

18. A network data processing system comprising:

¹ Of these claims, only claims 11, 14, 16, 18, 21, and 23 are argued separately. (Br. 11-16.)

means for initiating a network bootstrap program at a target device, the target device to be remotely booted by the server;

means for sending a command requesting an operating systems list of at least one operating system;

means for receiving the operating systems list prior to executing an operating system at the target device; and

means for selecting a target operating system from the operating systems list at the target device.

The following rule applies to appeal briefs:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

37 C.F.R. § 41.37(c)(1)(v)(2006).² Such identification "is considered important to enable the Board to more quickly determine where the claimed

² We cite to the version of the Code of Federal Regulations in effect at the time the instant Appeal Brief was filed.

subject matter is described in the application." M.P.E.P. § 1205.02 (8th ed., Rev. 5, Aug. 2006).³

The discussion in the *Summary of the Claimed Subject Matter* ("*Summary*") (Br. 8) of several means-plus-function limitations recited by independent claim 11 is not commensurate with the scope of the claim. Instead, the *Summary* appears to discuss limitations found in claim 18 rather than claim 11. In at least three instances, as discussed below, the purported means-plus-function limitation discussed in the *Summary* is contrary to the actual means-plus-function limitation recited by claim 11, but is similar to a means-plus-function limitation recited by claim 18.

First, claim 11 recites a "means for *receiving* a command requesting an operating systems list of at least one operating system." But the *Summary* discusses a purported limitation of a "means for *sending* 406 a bootstrap list command from the target device 108, 110, 112 to the server 104, 105." (Br. 8 (emphasis added).) Accordingly, the discussion of this limitation in the *Summary* is contrary to the actual claim language. We note that claim 18 recites, similarly to the discussion in the *Summary*, a "means for sending a command requesting an operating systems list of at least one operating system." Therefore, it appears that this discussion in the *Summary* may be directed to claim 18 rather than claim 11.

Second, claim 11 recites a "means for *sending* the operating systems list *to the target device* before an operating system is executed at the target device." However, the *Summary* discusses a limitation of a "means for *receiving* 516 an operating systems list of at least one operating system prior

³ We cite to the version of the Manual of Patent Examining Procedure in effect at the time the instant Appeal Brief was filed.

to executing an operating system *at the target device* 108, 110, 112." (Br. 8 (emphasis added).) Accordingly, the discussion of this limitation in the *Summary* is contrary to the actual claim language. We note that claim 18 recites, similarly to the discussion in the *Summary*, a "means for receiving the operating systems list prior to executing an operating system at the target device." Therefore, it appears that this discussion in the *Summary* may be directed to claim 18 rather than claim 11.

Third, claim 11 recites a "means for *receiving a selection* of a target operating system from the operating systems list." But the *Summary* discusses a limitation of a "means for *selecting* 518 a target operating system from the operating systems list." (Br. 8 (emphasis added).) Accordingly, the discussion of this limitation in the *Summary* is contrary to the actual claim language. We note that claim 18 recites, similarly to the discussion in the *Summary*, a "means for selecting a target operating system from the operating systems list at the target device." Therefore, it appears that this discussion in the *Summary* may be directed to claim 18 rather than claim 11.

Thus, the discussion of claim 11 in the *Summary* leaves us with substantial uncertainty as to what Appellants understand to be the corresponding structure, acts, or materials from the originally filed specification corresponding to the recited "means for receiving a command," "means for sending the operating systems list," and "means for receiving a selection of a target operating system."

With respect to claims 16 and 23, which depend from claims 11 and 18 respectively, we note that although these claims recite additional means-plus-function limitations, the *Summary* does not address them. (Br. 8.)

Instead, the discussion of claims 16 and 23 found in the *Summary* appears to be a copy of the earlier discussion in the *Summary* of the method limitation recited by dependent claim 8. (Br. 7-9.)

We decline to substitute our speculation about where the structure corresponding to the claimed subject matter is described in the Specification for the greater certainty that should come from the Appellants. Appellants are required to identify, in independent claim 11 and in separately argued dependent claims 16 and 23, each "means-plus-function" limitation and provide a mapping to the specification and drawings. In particular, the mapping of each of the claimed limitations shall include specific reference characters of the drawings and pages and lines of the specification. We find such a mapping to be necessary and prudent for a meaningful review. With the claims interpreted in the proper context, we will be better able to make an informed evaluation of the prior art in a comparison to the properly interpreted structure of independent claim 11 and dependent claims 16 and 23.

We leave it to the Examiner to further consider, after Appellants identify the corresponding structure, acts and materials in the Specification, whether this disclosure is sufficient under 35 U.S.C. § 112, First and Second Paragraphs.

The Examiner is required to take other appropriate action as needed.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- (1) notify Appellants of the non-compliant Brief and require submission of a Brief in compliance with 37 C.F.R. § 41.37;
- (2) consider Appellants' compliance with 35 U.S.C. § 112, First and Second Paragraphs, in light of the identification of corresponding structure; and
- (3) take such further action as may be appropriate.

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Frank C. Nicholas
CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201